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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,816	03/30/2000	James B. Armstrong	533/054	7812

26291 7590 04/21/2004

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ART UNIT	**PAPER NUMBER**
2611	13

DATE MAILED: 04/21/2004

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 13

Application Number: 09/538,816
Filing Date: March 30, 2000
Appellant(s): ARMSTRONG ET AL.

Eamon J. Wall
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 01/16/04.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct. A typographical error, however, is present on Line 1, which states that, "Claims 1-16 were presented in the application as original filed on March 30, 2000." The Examiner believe that the "16" should be correctly read --15--.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-9 and 10-15 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

PCT WO/98/48566	Mankovitz	10-1998
5729280	Inoue et al.	3-1998
5724521	Dedrick	3-1998

(10) Grounds of Rejection

Claims 1-2, 4 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over International Patent Application WO 98/48566 to Mankovitz in view of U.S. Patent No. 5,729,280 to Inoue et al. This rejection is set forth in prior Office Action, Paper No. 8.

Claim 3,5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz in view of Inoue and further in view of U.S. Patent No. 5,724,521 to Dedrick. This rejection is set forth in prior Office Action, Paper No. 8.

Claim10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick in view of Mankovitz and further in view of Inoue. This rejection is set forth in prior Office Action, Paper No. 8.

(11) Response to Argument

After thorough consideration of Appellant's repetitive arguments with respect to the rejected Claims 1-15, the Examiner has identified two separate issues, which will be addressed below. The first issue deals with the purported differences between Near Video On Demand (NVOD) and Video On Demand (VOD) as argued by Appellant with respect to Claims 1-15. In each of Appellant's arguments, the distinction between NVOD as disclosed by Inoue and VOD as disclosed by the instant application are the central issue. The second issue deals with the claimed "applet" comprising a video layer, a control layer and a graphics layer as argued by Appellant with respect to Claim 8.

VOD, as disclosed by Appellant, is a method of transmitting video programming such as a movie, live event, or other premium programming to a television viewer when requested. Such a system is often referred to as "Pay Per View." As the name suggests, VOD is provided to a user nearly instantaneously after a user requests a program to be delivered. A server or video recording device provides the data directly, and on a one-to-one basis, to the viewer over a network such as a cable television or satellite connection.

NVOD, as disclosed by Inoue et al., is a method of providing video programming such as a movie, live event, or other premium programming to a television viewer when requested. NVOD may also be referred to as "Pay Per View." As the name suggests, NVOD is provided to

a user within a certain delay after a user requests a program to be delivered, usually not more than several minutes. In a typical NVOD system, a server or video recording device provides the data to a plurality of users in a cyclical fashion, such as every five minutes. All users who request to view the content within the five-minute window will be given access to a common broadcast. Thus it can be seen that NVOD is a subset of VOD providing the same functionality with various cost/performance trade-offs. This will be further discussed below.

Appellant's invention, in short, is a system for providing VOD programming to a user. The user may pause the VOD content and view a secondary content. The secondary content is targeted advertising. When the user requests resumption of the primary VOD content, the playing of the primary content is restarted.

Mankovitz discloses a method for providing television programming with additional data such as web page addresses, which are hidden in the programming (Page 5, Lines 15-25). The user is able to press a button on a remote control (Page 5, Lines 34-35), which causes the television programming that is being displayed (See Figure 4) to be paused (Page 8, Line 34) such that the Internet web page content may be displayed (See Figure 2 and Page 7, Lines 30 – Page 8, Line 2). While the viewer is interacting with the secondary content, the television programming is stored to a recording device, while paused video frame is displayed in video window 42. When the user is done viewing the secondary content, they may resume the display of the television program from the point at which they left off (Page 8, Lines 3-4).

Appellant makes numerous references to the fact that the additional data ("Program Related Information" or "PRI") is embedded in the vertical blanking interval (VBI) of the television programming in the system of Mankovitz. The Examiner fails to see what relevance

this has to the argument or the claims as the PRI in the VBI is not what being read as the claimed "Secondary Content." The Secondary Content is clearly the Internet-based web page itself that the user is operable to navigate. The PRI merely provides the television program with a link into the Internet and the VBI carries this information.

Inoue et al. discloses a method for providing NVOD content (Col. 3, Line 51) to the user of television system (Col. 4, Line 4). It is inherent that this NVOD content must originate at a server or head-end device and be transmitted over a communication medium such as a cable television or satellite path. A user is able to issue a pause command (Col. 5, Line 59) which causes the video to be paused and another program or graphic to be displayed (Col. 6, Lines 28-32). Further, the invention of Inoue behaves "much like a video-on-demand signal receiver" (Col. 2, Lines 34-38). Buffer memory (Col. 4, Line 36-37) is used to pre-store NVOD content such that when a user requests to view a desired program, it is started immediately without any significant delay (Col. 8, Lines 35-43). In this regard, the system of Inoue is able to circumvent the largest disadvantage of the NVOD system, that is, the start up delay.

Appellant makes numerous claims that VOD has many advantages over a near video-on-demand system (See Appeal Brief, Page 41, Paragraph 2). Further Appellant mistakenly states that VOD "does not require nearly the amount of bandwidth required by a NVOD system to deliver content." Appellant further states that, "a VOD system only requires a single content stream per program to be sent to the user. That reduces the bandwidth requirements by a factor of 6..." The Examiner respectfully disagrees. VOD systems require a single content stream per program ***per user***. That is, the bandwidth (or channel space requirements on a television network) required increases linearly as more users request a program, regardless of whether the

viewers are all watching the same movie or not. Therefore, if six users are watching a movie at the same time in a VOD system, it uses ***the same*** amount of bandwidth as the NVOD system of Mankovitz. If sixty users are watching movies at the same time in a VOD system, it uses ***ten times*** the bandwidth as the NVOD system of Mankovitz. This illustrates the tradeoff in cost/performance of NVOD and VOD as stated above. Further, as the Examiner has maintained throughout prosecution, Appellant makes no claims to, nor suggests any reason why VOD is necessary over NVOD in a system of providing targeted advertisements to a viewer. In effect they both perform the same function, display the same content, and as demonstrated by Inoue, both are provided instantaneously. Therefore, the Examiner believes Appellant's arguments are neither relevant to the claims nor to the invention.

Regarding Appellant's argument with regard to Claim 8 that the claimed "applet" is not inherently taught, the Examiner refers to the American Heritage Dictionary, 4th edition which defines an applet as, "An application that has limited features, requires limited memory resources, and is usually portable between operating systems." As stated above, the Mankovitz reference teaches the display of World Wide Web pages (Page 6, Lines 10-36) in an Internet-enabled television device (Page 4, Lines 11-25). As shown in Figure 2, a television video screen (42) displays a video frame, while a web browser area (46) displays the secondary content. It is inherent that the screen of Figure 2, which is generated by a computing device, is controlled by a software application. This software application reads on the claimed applet and provides, among things, functionality for displaying video screen 42, functionality for displaying a website in area 46, and functionality for enabling the user to navigate through the website (Page 6, Lines 35-36). This reads on the claimed video, graphics, and control layers, respectively. Furthermore, as is

well known in the art, a web browser such as the one in area 46, may receive and execute an applet from a web page on the Internet.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Matthew R. Demicco
April 16, 2004

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